

1 ¹³ 32. (Amended) The method of claim ¹⁰ 29 further comprising the steps of moving the first member away from
2 the second member while maintaining the first member and the second member in grasping
3 contact with the surface of the heart.

Remarks

Claims 20-32 are pending in the application and amended above.

Some amendments only clarify that a paddle is not limited to having only a single suction port, because the former claim language did not explicitly use the phrase "at least one." However, the prior claim language did in fact include both singular and plural numbers of ports on a given paddle, because the plain reading of the claims prior to amendment did not specifically exclude multiple ports. Put another way, the limitation to "a first suction port" is literally met by a single suction port as well as by a plurality of suction ports; in the latter case, one simply could not have a plurality of suction ports if one did not have at least a single suction port. Therefore, the scope of the claims has not been limited.

Another clarification is the use of "primary" to indicate suction port(s) on the first paddle, and "secondary" for suction port(s) on the second paddle. This is not intended to imply any priority in importance, order of application to the tissue, etc., nor is it intended to limit the scope of the claims.

Similarly, clarification of suction sources as either "first" or "another" has been made, although it is believed the former claim language did not explicitly exclude using a single suction source on both first and second members, nor did it explicitly exclude using first and second suction sources on respective first and second suction members. Again, no limitation on the scope of the claims is intended.

Also, again for purposes of clarification, "providing access" has been used instead of the arguably more limited "cutting." Surgical access to the interior of the chest cavity would appear to inherently require cutting in the broadest sense of the term, which surely does not require a sharp instrument given that laser "cutting" of tissue is known.

Other amendments, such as using "in which" instead of "wherein," are simply intended to increase the readability of the claims by the public and not to change their scope.

Claims 20-32 were provisionally rejected under the judicially created doctrine of double patenting. A Terminal Disclaimer is enclosed to overcome any actual rejection which may be made.

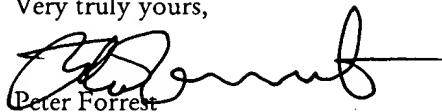
Claims 20-24 and 26-32 were rejected under 35 USC §112, second paragraph, for indefiniteness. The preamble of each claim has been amended as suggested by the Examiner. Claim 30 has been corrected as noted by the

30

Examiner.

Please allow all pending claims in light of these remarks. If you have any questions, please contact me at your convenience.

Very truly yours,



Peter Forrest

Registration Number 33,235
Attorney for Applicants

October 13, 1998

MEDTRONIC, INC.
7000 Central Avenue NE
Minneapolis, Minnesota 55432 USA
(612) 514-6402 (direct voice line)
(612) 514-3323 (direct facsimile)
peter.forrest@medtronic.com (e-mail)

D